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DP

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/245,493 02/05/99 CINCOTTA

D 2435.1

005514 TM02/1109
FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK NY 10112

 EXAMINER

NGUYEN, N

 ART UNIT PAPER NUMBER2164 *6***DATE MAILED:**

11/09/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No. 09/245,493	Applicant(s) Cincotta
Examiner Nga B. Nguyen	Group Art Unit 2764 3164

Responsive to communication(s) filed on Jul 31, 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

Claim(s) 1-25 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
 Claim(s) _____ is/are allowed.
 Claim(s) 1-25 is/are rejected.
 Claim(s) _____ is/are objected to.
 Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
 The drawing(s) filed on _____ is/are objected to by the Examiner.
 The proposed drawing correction, filed on _____ is approved disapproved.
 The specification is objected to by the Examiner.
 The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 All Some* None of the CERTIFIED copies of the priority documents have been
 received.
 received in Application No. (Series Code/Serial Number) _____
 received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892
 Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
 Interview Summary, PTO-413
 Notice of Draftsperson's Patent Drawing Review, PTO-948
 Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. This Office Action is the answer to the communication filed on July 31, 2000 , which paper has been placed of record in the file.
2. Claims 1-25 are pending in this application.

Response to Arguments/Amendment

3. Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground of the rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claim 5 is rejected under 35 U.S.C. 102(a) as being anticipated by Walker et al, U.S.

Patent No. 5,794,207.

Regarding claim 5, Walker discloses a financial data processing system for allowing a plurality of participants to prepay for services or goods to be received at a later date from one of a plurality of specified providers, the choice of which of which of the plurality of providers will

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deliver the services or goods being made by a participant at the time the goods and services are to be delivered:

a machine-readable storage devices which stores data indicating measures of services or goods for which each participant has prepaid and measures of services or goods which each provider has contracted to provide (column 12, lines 54-67);

a processing circuit for determining, for each of the providers, a predicted total measure of services or goods that will be required from that provider by the aggregate of the plurality of participants (column 12, lines 3-53).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al, U.S. Patent No. 5,794,207 in view of Walker et al, U.S. Patent No. 6,134,534.

Regarding claim 1, Walker (US 5,794,207) discloses a method, to be administered by an administrating entity, for allowing a plurality of participants to prepay for services or goods to be received at a later date from one of a plurality of specified providers, the method comprising the steps of:

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executing contracts between the administrating entity and each of the plurality of participants in which a contracting participant pays to the administrating entity a cash amount and in return receives from the administrating entity a promise to deliver at a future date a specified measure of services or goods, (column 16, lines 12-63; column 19, lines 29-45 and column 21, lines 1-60);

determining, for each of the plurality of specified providers, a predicted total measure of services or goods that will be required from that provider by the aggregate of the plurality of participants (column 31, lines 15-67); and

executing contracts between the administrating entity and each of the plurality of specified providers in which the administrating entity pays to a contracting provider a cash amount and in return receives from the contracting provider a promise to deliver a specified measure or services or goods (column 21, lines 1-15 and column 29, lines 7-17).

Walker (US 5,794,207) does not disclose the services or goods to be provided by whichever of the plurality of specified providers the contracting participant selects. However, Walker (US 6,134,534) discloses the services or goods to be provided by whichever of the plurality of specified providers the contracting participant selects (column 3, lines 35-47). It would have been obvious to one with ordinary skill in the art at the time the invention was made to include the feature above with Walker's (US 5,794,207) for the purpose of allowing customer can select any specified provider that customer desires to bind the contract.

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Regarding claim 2, Walker discloses the administrating entity ascertains the measure of services or goods to be specified in each contract with a provider in accordance with the predicted total measure of services or goods that will be required from that provider (column 19, lines 12-54).

Claims 3 and 4 are written in means and parallel limitations as found in claims 1 and 2, respectively, therefore, are rejected by the same rationale.

Claims 24 is written in computer software and parallel limitations as found in claim 1, therefore is rejected by the same rationale.

8. Claims 6-23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al, U.S. Patent No. 5,794,207 in view of Mottola et al, U.S. Patent No. 5,809,484.

Regarding claim 6, Walker (US 5,794,207) discloses a method, to be administered by an administrating entity, for allowing a plurality of participants to prepay for services or goods to be received at a later date from one of a plurality of specified providers, the method comprising the steps of:

executing contracts between the administrating entity and each of the plurality of participants in which a contracting participant pays to the administrating entity a cash amount and in return receives from the administrating entity a promise to deliver at a future date a specified measure of services or goods (column 16, lines 12-63; column 19, lines 29-45 and column 21, lines 1-60);

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determining, for each of the plurality of specified providers, a predicted total measure of services or goods that will be required from that provider by the aggregate of the plurality of participants (column 31, lines 15-67); and

executing contracts between the administrating entity and each of the plurality of specified providers in which the administrating entity pays to a contracting provider a cash amount and in return receives from the contracting provider a promise to deliver a specified measure or services or goods (column 21, lines 1-15 and column 29, lines 7-17).

However, Walker (US 5,794,207) neither discloses the services or goods to be provided by whichever of the plurality of specified providers the contracting participant selects nor services contains educational service.. However, Walker (US 6,134,534) discloses the services or goods to be provided by whichever of the plurality of specified providers the contracting participant selects (column 3, lines 35-47). It would have been obvious to one with ordinary skill in the art at the time the invention was made to include the feature above with Walker's (US 5,794,207) for the purpose of allowing customer can select any specified provider that customer desires to bind the contract. Mottola teaches service is educational service (see abstract). It would have been obvious to one with ordinary skill in the art at the time the invention was made to include educational service in Walker's method for the purpose of providing participants such as parents can prepay tuition for college education to be received when their children reaches college age from any one of several colleges.

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Regarding claim 7, Mottola discloses the participants designate beneficiaries to whom the educational services will be provided (column 13, lines 31-55).

Regarding claim 8, Mottola discloses a beneficiary is designated by a participant at the time a contract between that participant and the administrating entity is executed (column 13, lines 43-50).

Regarding claim 9, Mottola discloses the contracts between the administrating entity and the participants comprise participant option contracts and the contracts between the educational institutions and the administrating entity comprise institution option contracts (columns 14-15).

Regarding claim 10, Mottola discloses the contracts between the administrating entity and the participants comprise participant option contracts and the contracts between the educational institutions and the administrating entity comprise institution forward contracts (columns 14-15).

Regarding claim 11, Mottola discloses the contracts between the administrating entity and the participants comprise participant forward contracts and the contracts between the educational institutions and the administrating entity comprise institution option contracts (columns 14-15).

Regarding claim 12, Mottola discloses the contracts between the administrating entity and the participants comprise participant forward contracts and the contracts between the educational institutions and the administrating entity comprise institution forward contracts (columns 14-15).

Regarding claims 13-14, Mottola discloses the participant option contracts are deep-in-the-money option contracts (column 17, lines 7-43).

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Regarding claim 15, Walker discloses the determination process for each of the plurality of specified educational institutions comprises:

examining an educational institution data record (column 19, lines 13-45);

examining a participant data record for each of the plurality of participants (column 17, lines 8-47);

comparing the educational institution data record with each participant record to determine a predicted total measure of education that each participant will require from the particular education institution (column 18, lines 15-33); and

summing the predicted total measure of education that each participant will require from the particular educational institution to determine for each of the plurality of specified educational institutions a predicted total measure of educational services that will be required from that educational institution by the aggregate of the plurality of participants (column 18, line 56-column 19, line 28).

Regarding claim 16, Mottola discloses educational institution data records include statistical information describing the historical makeup of the particular educational institution's student body (column 6, lined 10-65).

Regarding claim 17, Mottola discloses statistical information includes information describing academic performance prior to admission (column 4, lines 10-15).

Regarding claim 18, Mottola discloses statistical information includes information describing scholastic aptitude test scores (column 4, lines 2-4).

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Regarding claim 19, Mottola discloses statistical information includes information describing geographic origin of students (column 6, lines 38-50).

Regarding claim 20, Mottola discloses participants data records include data describing the compounding beneficiaries geographic locale (column 6, lines 38-50).

Regarding claim 21, Mottola discloses participants data records include data describing the compounding beneficiaries academic performance (column 4, lines 15-30).

Regarding claim 22, Mottola discloses participants data records include data describing the compounding beneficiaries scholastic aptitude test scores (column 4, lines 2-4).

Regarding claim 23, Mottola discloses participants data records include data describing the measure of educational services that has been promised by the administrating entity to the particular participant (column 15, lines 29-40).

Claim 25 is written in computer software and parallel limitations as found in claim 6, therefore is rejected by the same rationale.

Conclusion

9. Claims 1-25 are rejected.
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen, whose telephone number is (703)306-2901. The examiner can normally be reached on Monday-Friday from 7:30 AM-5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A. Millin, can be reached on (703)308-1065.

11. Any response to this action should be mail to:

Commissioner of Patents and Trademarks
c/o Technology Center 2700
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

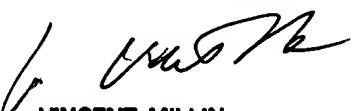
or:

(703) 308-5397 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II,
2121 Crystal Drive, Arlington,
VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)305-3900.

Nga B. Nguyen
November 3, 2000


VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

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ATTACHMENT TO AND MODIFICATION OF
NOTICE OF ALLOWABILITY (PTO-37)
(November, 2000)

**NO EXTENSIONS OF TIME ARE PERMITTED TO FILE
CORRECTED OR FORMAL DRAWINGS, OR A SUBSTITUTE
OATH OR DECLARATION**, notwithstanding any indication to the
contrary in the attached Notice of Allowability (PTO-37).

If the following language appears on the attached Notice of Allowability, the portion lined through below is of no force and effect and is to be ignored¹:

A SHORTENED STATUTORY PERIOD FOR RESPONSE to comply with the requirements noted below is set to EXPIRE **THREE MONTHS** FROM THE "DATE MAILED" of this Office action. Failure to comply will result in ABANDONMENT of this application. ~~Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).~~

Similar language appearing in any attachments to the Notice of Allowability, such as in an Examiner's Amendment/Comment or in a Notice of Draftperson's Patent Drawing Review, PTO-948, is also to be ignored.

¹ The language which is crossed out is contrary to amended 37 CFR 1.85(c) and 1.136. See "Changes to Implement the Patent Business Goals", 65 Fed. Reg. 54603, 54629, 54641, 54670, 54674 (September 8, 2000), 1238 Off. Gaz. Pat. Office 77, 99, 110, 135, 139 (September 19, 2000).